

REMARKS

The Examiner has maintained his rejection. As set forth below, such new rejection is still deficient. However, despite such deficiencies and in the spirit of expediting the prosecution of the present application, applicant has incorporated the subject matter of Claim 6 et al. into the independent claims. Since the subject matter of such dependent claims was already considered by the Examiner, it is asserted that such claim amendments would not require new search and/or consideration.

The Examiner has maintained the objection to Claims 1, 2, 4-12, 14-22, 24-30, 41, and 42 due to informalities. Applicant respectfully asserts that such objection was deemed avoided in view of the clarifications made to independent Claims 1, 11, and 21 in Amendment B mailed 03/18/2008. Reconsideration of the objection is respectfully requested.

The Examiner has objected to Claims 32 and 34-40 due to informalities. Applicant respectfully asserts that such objection has been avoided in view of the clarifications made to dependent Claims 32, 34-35, and 37-40.

Further, the Examiner has argued that "applicant's use of optional language (e.g. 'if' in claim 1) allows for the 'if not' option to read on the claim" and has further argued that "it is the Examiner's opinion that these limitations do not distinguish the claim from the prior art." Applicant respectfully disagrees. For example, with respect to independent Claim 1, applicant notes that applicant's language is not limited to the "if not" option, but instead discloses "if said licence key is valid, then: (i) downloading said computer program product to said user computer; and (ii) installing said computer program product to be resident upon said user computer," as claimed by applicant.

In the Office Action mailed 08/14/2008, the Examiner has argued that "the Examiner's position is supported by MPEP 2106 II C (paragraph 4+), wherein it states, 'Language that suggests or makes optional but does not require steps to be performed or

does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.” Further, the Examiner has argued that “[t]his is also supported by *Intel Corp. v. International Trade Commission*, 20 USPQ2d 1161 (Fed. Cir. 1991), wherein it was determined that, given two possibilities by the claim, an invention only needs to have one of them to infringe.” In addition, the Examiner has argued that “[c]learly, by Applicants use of the word ‘if,’ they recognize that there are two possibilities: the condition can be satisfied or it can not be satisfied” and that the “[a]pplicants provide steps that may be taken if it is satisfied.” Still further, the Examiner has argued “that the condition may not be satisfied” and that in this case “the steps would not be performed.”

Applicant respectfully disagrees and asserts that MPEP 2106 II C (paragraph 4+) states that “[l]anguage that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation” (emphasis added). However, applicant clearly claims “(i) downloading said computer program product to said user computer; and (ii) installing said computer program product to be resident upon said user computer” (emphasis added), when “said licence key is valid,” as claimed by applicant. Clearly, downloading and installing, as claimed, are steps that are required to be performed when “said licence key is valid,” as claimed by applicant. Therefore, applicant’s claim language is clearly directed towards statutory subject matter.

Additionally, the Examiner has rejected Claims 1, 2, 4, 5, 8-12, 14, 15, 18-22, 24, 25, 28-32, 34, 35, and 38-41 under 35 U.S.C. §103(a) as being unpatentable over Ishibashi et al. (U.S. Patent No. 7,124,443). In addition, the Examiner has rejected Claims 6, 16, 26, and 36 under 35 U.S.C. §103(a) as being unpatentable over Ishibashi, in view of Official Notice. Applicant respectfully disagrees with such rejections, especially in view of the amendments made hereinabove to the independent claims. Specifically, applicant has amended the independent claims to at least substantially include the subject matter of former dependent Claim 6 et al.

With respect to independent Claims 1 and 11, the Examiner has relied on the “Contents Use Right Discrimination Card” and “Discriminating Data” elements of Figure 3 from the Ishibashi reference to make a prior art showing of applicant’s claimed “obtaining a licence ticket bearing a licence key.”

Applicant respectfully asserts that the excerpts relied on by the Examiner merely disclose a “content use rights discrimination card” onto which “is recorded the identifiers necessary to acquire the decoding key of the encrypted content” (Col. 9, lines 20-22, not specifically cited – emphasis added). Further, Ishibashi discloses that “[t]he user... sends the identification data recorded on the content use rights discrimination card [i.e., “discriminating data”] to the content use rights sale center” (Col. 10, lines 1-3, not specifically cited – emphasis added), and that “[i]f... the content use rights sale center 605 determines that content use rights is to be issued to the user, the decoding key is distributed to the user (Column 10, lines 14-17, not specifically cited – emphasis added).

However, merely disclosing that data from a content use rights discrimination card is sent from a user to a content use rights sale center, which determines whether content use rights should be issued to a user and distributes the decoding key to the user after the determination, fails to disclose “obtaining a licence ticket bearing a licence key” (emphasis added), as claimed by applicant. Distributing the decoding key to a user after the user sends the content use rights discrimination card to a content use rights sale center for a content use rights issuance determination does not disclose “a licence ticket” that “bear[s] a licence key,” as claimed.

In the Office Action mailed 08/14/2008, the Examiner has argued that “[w]hile not expressly [referred] to as a key, the discrimination data is used in the same manner as the key in the instant application.” Further the Examiner has argued that “[t]he label applied to a piece of data is inconsequential to the function it performs and moreover, it is the function that is claimed not the label of the data.”

Applicant respectfully disagrees and asserts the excerpts relied on by the Examiner merely disclose a “content use rights discrimination card” onto which “is recorded the identifiers necessary to acquire the decoding key of the encrypted content” (Col. 9, lines 20-22, not specifically cited – emphasis added). Furthermore, Ishibashi teaches that “[t]he content use rights sale center 605 determines whether or not the identification data, recorded on the content use rights discrimination card received from the user is authentic,” and that “[i]f, after checking for the above items, the content use rights sale center 605 determines that content use rights is to be issued to the user, the decoding key is distributed to the user” (Col. 10, lines 10-17 – emphasis added).

However, disclosing identifiers recorded on a content use rights discrimination card, where a content use rights sale center 605 determines if the identification data, recorded on the content use rights discrimination card, is authentic, in addition to distributing the decoding key to the user if it is determined that content use rights are to be issued to the user, as in Ishibashi, simply fails to specifically meet applicant’s claimed “licence ticket bearing a licence key” (emphasis added), as claimed by applicant. Clearly, the content use rights sale center distributing the decoding key to the user if the identification data recorded on the content use rights discrimination card is authentic, as in Ishibashi, simply fails to even suggest applicant’s claimed “licence ticket bearing a licence key” (emphasis added), as claimed by applicant.

With respect to independent Claims 21 and 31, the Examiner has again relied on the “Contents Use Right Discrimination Card” and “Discriminating Data” elements of Figure 3 from the Ishibashi reference to make a prior art showing of applicant’s claimed “receiving a licence key input by a user at said user computer, said licence key being borne by a licence ticket obtained by a user” (see this or similar, but not necessarily identical language, in each of the aforementioned claims).

Applicant again notes that the excerpts relied on by the Examiner merely teaches that data from a content use rights discrimination card is sent from a user to a content use rights sale center, which determines whether content use rights should be issued to a user

and distributes the decoding key to the user after the determination, which fails to disclose “receiving a licence key input by a user at said user computer, said licence key being borne by a licence ticket obtained by a user” (emphasis added), as claimed by applicant. Distributing the decoding key to a user after the user sends the content use rights discrimination card to a content use rights sale center for a content use rights issuance determination does not disclose “receiving a licence key input by a user at said user computer” where “said licence key [is] borne by a licence ticket obtained by a user” (emphasis added), as claimed.

In the Office Action mailed 08/14/2008, the Examiner has again argued that “[w]hile not expressly [referred] to as a key, the discrimination data is used in the same manner as the key in the instant application.” Further the Examiner has argued that “[t]he label applied to a piece of data is inconsequential to the function it performs and moreover, it is the function that is claimed not the label of the data.”

Applicant respectfully disagrees and asserts the excerpts relied on by the Examiner merely disclose a “content use rights discrimination card” onto which “is recorded the identifiers necessary to acquire the decoding key of the encrypted content” (Col. 9, lines 20-22, not specifically cited – emphasis added). Furthermore, Ishibashi teaches that “[t]he content use rights sale center 605 determines whether or not the identification data, recorded on the content use rights discrimination card received from the user is authentic,” and that “[i]f, after checking for the above items, the content use rights sale center 605 determines that content use rights is to be issued to the user, the decoding key is distributed to the user” (Col. 10, lines 10-17 – emphasis added).

However, disclosing identifiers recorded on a content use rights discrimination card, where a content use rights sale center 605 determines if the identification data, recorded on the content use rights discrimination card, is authentic, in addition to distributing the decoding key to the user if it is determined that content use rights are to be issued to the user, as in Ishibashi, simply fails to meet applicant’s claimed “receiving a licence key input by a user at said user computer” where “said licence key [is] borne by a

licence ticket obtained by a user” (emphasis added), as claimed by applicant. Clearly, the content use rights sale center distributing the decoding key to the user if the identification data recorded on the content use rights discrimination card is authentic, as in Ishibashi, simply fails to even suggest applicant’s claimed “receiving a licence key input by a user at said user computer” where “said licence key [is] borne by a licence ticket obtained by a user” (emphasis added), as claimed by applicant.

With respect to independent Claims 1 and 11, the Examiner has relied on Col. 8, line 45, in addition to items 601 and 603 from the above reference to make a prior art showing of applicant’s claimed “inputting at a user computer a download source computer address of a download source computer of a supplier of said computer program product.” In addition, the Examiner has argued that “[t]he address has to be know[n] to the user computer in order to have the download initiated, therefore, it had to be inputted.”

Applicant respectfully disagrees and asserts that the excerpt relied on by the Examiner merely discloses a “[a] content provider” which “suppl[ies] software content” (Col. 8, line 45). However, merely disclosing a content provider fails to teach “inputting at a user computer a download source computer address of a download source computer of a supplier of said computer program product” (emphasis added), as claimed by applicant. Nowhere in the above excerpt is a “download source computer address of a download source computer of a supplier of said computer program product” taught that is “input[t] at a user computer” (emphasis added), as specifically claimed.

In addition, it appears that the Examiner has relied on an inherency argument regarding the above emphasized claim limitations. In view of the arguments made hereinabove, any such inherency argument has been adequately rebutted, and a notice of allowance or a specific prior art showing of such claim features, in combination with the remaining claim elements is respectfully requested. (See MPEP 2112)

In the Office Action mailed 08/14/2008, the Examiner has argued that “as noted by Applicants, the functionality is inherent” since “[n]owhere in the arguments did applicant rebut the fact that a computer has to know the address to communicate with another computer, or that in order to know the address it has to be input.”

First, applicant respectfully disagrees and asserts that in Amendment B mailed 03/18/2008, applicant has clearly disagreed with the Examiner’s statement that “[t]he address has to be know[n] to the user computer in order to have the download initiated, therefore, it had to be inputted.” Second, applicant asserts that, for example, Ishibashi teaches that “[a] user who desires access to various content... utilizes the user terminal 601 to have encrypted content distributed from content providers 602 to 604 via the network or to acquire the content stored in a storage medium 606” (Col. 8, lines 45-50 – emphasis added). Clearly, the mere disclosure of utilizing the user terminal 601 to have encrypted content distributed from content providers 602 to 604 via the network, as in Ishibashi, simply fails to even suggest that the “download source computer address of a download source computer of a supplier of said computer program product” is “input[t] at a user computer” (emphasis added), as specifically claimed.

In addition, the Examiner has provided “How the Internet Works by Preston Gralla as support for his inherency argument” and has specifically relied upon “Chapters 4 and 5 [which] teach about addresses and their critical role in a connection.”

Applicant notes the Examiner has relied on How the Internet Works, which constitutes a reference separate from those in the relevant rejection under 35 U.S.C. 103(a). Further, it is noted that the Examiner has failed to cite specific motivation in the relevant reference(s) to support the case for combining the How the Internet Works reference. The Examiner is reminded that the Federal Circuit requires that there must be some logical reason apparent from the evidence of record that would justify the combination or modification of references. In re Regel, 188 USPQ 132 (CCPA 1975). Thus, the reliance on the How the Internet Works reference, on its face, is clearly improper.

Again, applicant respectfully asserts that view of the arguments made hereinabove, any such inherency argument has been adequately rebutted, and a notice of allowance or a specific prior art showing of such claim features, in combination with the remaining claim elements is respectfully requested. (See MPEP 2112)

Furthermore, in response, applicant asserts that the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

With respect to Claims 1 and 11, the Examiner has relied on “Arrows from 601 to 605 to 607 to 603” in Figure 3 from the above reference to make a prior art showing of applicant’s claimed “transmitting said licence key from said user computer to said download source computer via said computer network connection.”

Applicant respectfully disagrees and asserts that the “Arrows from 601 to 605” in Figure 3 refers to “discriminating data.” Additionally, Ishibashi discloses that “[t]he user... sends the identification data recorded on the content use rights discrimination card [i.e., “discriminating data”] to the content use rights sale center” (Col. 10, lines 1-3, not specifically cited – emphasis added), and that “[i]f... the content use rights sale center 605 determines that content use rights is to be issued to the user, the decoding key is distributed to the user (Column 10, lines 14-17, not specifically cited – emphasis added).

However, merely disclosing that a user sends identification data to a content use rights sale center, which determines whether content use rights are to be issued and sends a decoding key to the user, as in Ishibashi, does not teach, and in fact *teaches away* from, “transmitting said licence key from said user computer to said download source computer via said computer network connection” (emphasis added), as claimed by applicant.

In the Office Action mailed 08/14/2008, the Examiner has argued that “[t]he argument pertaining to the licence key has been addressed above.” Further, the Examiner has argued that the “[a]pplicants are focusing on the labeling convention of the reference, and not using the citations used by the Examiner” and that “[t]he key referred to in the reference is *not* the same as what was cited as being the key in terms of the instant application.”

Applicant respectfully disagrees and asserts that, as argued above, the content use rights discrimination data is not the same as the “licence key,” as claimed by applicant. Further, applicant again respectfully asserts that merely disclosing that a user sends identification data to a content use rights sale center, which determines whether content use rights are to be issued and sends a decoding key to the user, as in Ishibashi, does not teach, and in fact *teaches away* from, “transmitting said licence key from said user computer to said download source computer via said computer network connection” (emphasis added), as claimed by applicant.

In addition, applicant respectfully asserts that the arrows from 601 to 605 to 607 to 603 in Figure 3 disclose that “[t]he content providers 602 to 604... provide the encrypted content to the user,” (Col. 9, lines 35-39, not specifically cited), that “[t]he user then sends the identification data recorded on the content use rights discrimination card to the content use rights sales center 605 via a network 607,” (Col. 10, lines 1-3, not specifically cited – emphasis added), and that if “the content use rights sale center 605 determines that content use rights is to be issued to the user, the decoding key is distributed to the user” (Col. 10, lines 14-17, not specifically cited – emphasis added).

However, merely disclosing that the user sends the identification data recorded on the content use rights discrimination card to the content user rights sales center via a network, and that the content use rights sale center distributes the decoding key to the user, in addition to disclosing that the content provider provides the encrypted content to the user, as in Ishibashi, does not teach, and in fact *teaches away* from, “transmitting said licence key from said user computer to said download source computer via said computer network connection” (emphasis added), as claimed by applicant.

Further, with respect to Claims 21 and 31, the Examiner has relied on “Arrows from 601 to 605 to 607 to 603” in Figure 3 from the above reference to make a prior art showing of applicant’s claimed “receiving a licence key input by a user at said user computer.”

Applicant again respectfully notes that merely disclosing that a user sends identification data to a content use rights sale center, which determines whether content use rights are to be issued and sends a decoding key to the user, as in Ishibashi, does not teach, and in fact *teaches away* from, “receiving a licence key input by a user at said user computer” (emphasis added), as claimed by applicant.

In the Office Action mailed 08/14/2008, the Examiner has argued that “[t]he argument pertaining to the licence key has been addressed above.” Further, the Examiner has argued that the “[a]pplicants are focusing on the labeling convention of the reference, and not using the citations used by the Examiner” and that “[t]he key referred to in the reference is *not* the same as what was cited as being the key in terms of the instant application.”

Applicant respectfully disagrees and asserts that, as argued above, the content use rights discrimination data is not the same as the “licence key,” as claimed by applicant. Further, applicant again respectfully asserts that merely disclosing that a user sends identification data to a content use rights sale center, which determines whether content

use rights are to be issued and sends a decoding key to the user, as in Ishibashi, does not teach, and in fact *teaches away* from, “receiving a licence key input by a user at said user computer” (emphasis added), as claimed by applicant.

In addition, applicant respectfully asserts that the arrows from 601 to 605 to 607 to 603 in Figure 3 disclose that “[t]he content providers 602 to 604... provide the encrypted content to the user,” (Col. 9, lines 35-39, not specifically cited), that “[t]he user then sends the identification data recorded on the content use rights discrimination card to the content use rights sales center 605 via a network 607,” (Col. 10, lines 1-3, not specifically cited – emphasis added), and that if “the content use rights sale center 605 determines that content use rights is to be issued to the user, the decoding key is distributed to the user” (Col. 10, lines 14-17, not specifically cited – emphasis added).

However, merely disclosing that the user sends the identification data recorded on the content use rights discrimination card to the content user rights sales center via a network, and that the content use rights sale center distributes the decoding key to the user, in addition to disclosing that the content provider provides the encrypted content to the user, as in Ishibashi, does not teach, and in fact *teaches away* from, “receiving a licence key input by a user at said user computer” (emphasis added), as claimed by applicant.

Further still, with respect to the independent claims, the Examiner has relied on the following excerpt from the above reference to make a prior art showing of applicant’s claimed technique “wherein when said licence ticket is purchased a seller of said licence ticket transmits data indicating sale of said licence ticket to said supplier of said computer program product” (see this or similar, but not necessarily identical language in the independent claims).

“The content use rights sale center 605 manages the information pertinent to the issue content use rights discrimination card in its database and also manages data indicating whether or not a decoding key for the content associated with the content use rights discrimination card that is identified by the serial number has already been distributed. The content use rights sale

center 605 determines whether or not the identification data, recorded on the content use rights discrimination card received from the user is authentic" (Column 10, lines 4-13 - emphasis added).

Applicant respectfully points out that the above excerpt relied on by the Examiner merely discloses that a "content use rights sale center... manages the information pertinent to the issue content use rights discrimination card... and also manages data indicating whether or not a decoding key... has already been distributed" (emphasis added). Further, the excerpt discloses that "[t]he content use rights sale center... determines whether or not the identification data, recorded on the content use rights discrimination card received from the user is authentic" (emphasis added).

However, merely disclosing that a sale center manages information pertinent to the issue content use rights discrimination card and manages data indicating whether a decoding key has been distributed, in addition to teaching that the sale center determines whether identification data on the issue content use rights discrimination card is authentic, fails to disclose that "a seller of said licence ticket transmits data indicating sale of said licence ticket to said supplier of said computer program product," much less a technique "wherein when said licence ticket is purchased a seller of said licence ticket transmits data indicating sale of said licence ticket to said supplier of said computer program product" (emphasis added), as claimed by applicant.

In addition, it appears that the Examiner has relied on an inherency argument regarding the above emphasized claim limitations. More specifically, the Examiner has argued that "[i]n order for the sale center 605 to know that the serial number has been distributed, it had to be reported by the seller." Applicant respectfully disagrees and notes that, in view of the arguments made hereinabove, any such inherency argument has been adequately rebutted, and a notice of allowance or a specific prior art showing of such claim features, in combination with the remaining claim elements is respectfully requested. (See MPEP 2112)

In the Office Action mailed 08/14/2008, the Examiner has argued that “to properly rebut the inherency, the inherency itself has to be addressed” and has maintained that “[i]n order for the sale center 605 to know that the serial number has been distributed, it had to be reported by the seller.”

Applicant respectfully disagrees and again asserts that Ishibashi clearly teaches that “[t]he user, at user terminal 601, purchases and receives the content use rights discrimination card,” that “[t]he user then sends the identification data recorded on the content use rights discrimination card to the content use rights sale center 605 via a network 607”, and that “[t]he content use rights sale center 605 manages the information pertinent to the issued content use rights discrimination card in its database” (Col. 9, line 64 - Col. 10, line 10 – emphasis added).

Therefore, Ishibashi simply teaches that the user purchases and receives the content use rights discrimination card and then sends the identification data to the content use rights sale center 605 that manages the information pertinent to the issued content use rights discrimination card in its database, which simply fails to suggest that “a seller of said licence ticket transmits data indicating sale of said licence ticket to said supplier of said computer program product,” much less applicant’s specifically claimed technique “wherein when said licence ticket is purchased a seller of said licence ticket transmits data indicating sale of said licence ticket to said supplier of said computer program product” (emphasis added), as claimed by applicant. Clearly, the rights sale center 605 managing the information pertinent to the issued content use rights discrimination cards in its database, in addition to the user, after purchase, sending the identification data to the content use rights sale center 605, as in Ishibashi, simply fails to even suggest that “a seller of said licence ticket transmits data indicating sale of said licence ticket to said supplier of said computer program product” (emphasis added), as claimed by applicant.

Again, applicant respectfully notes that, in view of the arguments made hereinabove, any such inherency argument has been adequately rebutted, and a notice of

allowance or a specific prior art showing of such claim features, in combination with the remaining claim elements is respectfully requested. (See MPEP 2112)

Furthermore, in response, applicant asserts that the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

Additionally, the Examiner has noted that "the provider 603 and the management center 605 [are shown] as separate servers" and has argued that "it would have been obvious to one of ordinary skill in the art... to have modified the teachings of Ishibashi to combine the two servers in order to make them integral (MPEP 2144.04), thus reducing the hardware and communications requirements." Applicant respectfully disagrees and notes that it would not be obvious to one of ordinary skill in the art to modify the teachings of Ishibashi in the manner suggested by the Examiner.

In the Office Action mailed 08/14/2008, the Examiner has failed to specifically respond to applicant's above arguments. Thus, a notice of allowance or a specific prior art showing of such claim features, in combination with the remaining claim elements is respectfully requested.

Furthermore, applicant respectfully asserts that Ishibashi specifically teaches that "[t]he content providers 602 to 604, who provide the encrypted content to the user, collect the content use fee when providing of the content use rights discrimination card to the users, thereby avoiding on-line fee collection from the users" and that "the

assignment of the counter-values responsive to the providing of the content use rights discrimination card to the users may be suitably made among the content providers, the content use rights sale center and even the retail stores, etc., which have sold the content use rights discrimination card” (Col. 9, lines 35-44 – emphasis added).

Therefore, Ishibashi’s specific teachings that the content providers 602 to 604 avoid on-line fee collection from the users and that the content use rights sale center sell the content use rights discrimination card clearly *teaches away* from the Examiner’s allegation that “it would have been obvious to one of ordinary skill in the art... to have modified the teachings of Ishibashi to combine the two servers in order to make them integral,” as alleged by the Examiner. Clearly, combining the two servers to make them integral would be unsatisfactory for the intended purpose of having the content providers 602 to 604 avoid on-line fee collection from the users. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

Applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above. Nevertheless, despite such paramount deficiencies and in the spirit of expediting the

prosecution of the present application, applicant has incorporated the subject matter of former Claim 6 et al. into the independent claims.

With respect to the subject matter of former Claim 6 et al. (now at least substantially incorporated into the independent claims), the Examiner has simply dismissed the same under Official Notice. Specifically, the Examiner has stated that applicant's claimed language is "merely... sale by consignment," that "it is notoriously old and well known in the art to sell goods by consignment," and that "[t]herefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to have modified the teachings of Ishibashi to use consignment in order to reduce the risk on the part of the seller, which makes them more likely to carry the product."

Applicant respectfully disagrees. In particular, applicant notes that merely disclosing that a sale center manages information pertinent to the issue content use rights discrimination card and manages data indicating whether a decoding key has been distributed, in addition to teaching that the sale center determines whether identification data on the issue content use rights discrimination card is authentic, as in Ishibashi, fails to even *suggest* "charg[ing] said seller for a licence to use said computer program product," much less a technique "wherein receipt of said data indicating sale of said licence ticket triggers said supplier of said computer program product to charge said seller for a licence to use said computer program product" (emphasis added), in the context claimed by applicant.

Applicant thus formally requests a specific showing of the subject matter in ALL of the claims in any future action. Note excerpt from MPEP below.

"If the applicant traverses such an [Official Notice] assertion the examiner should cite a reference in support of his or her position." See MPEP 2144.03.

In the Office Action mailed 08/14/2008, the Examiner has stated that "[a]pplicants' attempt at traversing the Official Notice findings as stated in the previous

Office Action (mailed 3/18/2008) is inadequate” and that “[a]pplicants mus[t] state *why* the Official Notice statement is not to be considered common knowledge or well known in the art.” Furthermore, the Examiner has stated that “[b]ecause Applicants’ traversal is inadequate, the Official Notice statement is taken to be admitted prior art” per “MPEP 2144.03.”

Applicant respectfully disagrees with the Examiner’s allegation that applicant’s claimed technique is “merely... sale by consignment,” which “allows for someone more experienced in sales to actually sell the product and thus the owner of the product does not have to deal with the sale.” Specifically, the Examiner has alleged that “it is... well known in the art to sell goods by consignment.” However, selling goods by consignment, simply fails to even suggest applicant’s specifically claimed technique “wherein receipt of said data indicating sale of said licence ticket triggers said supplier of said computer program product to charge said seller for a licence to use said computer program product” (emphasis added), in the context claimed by applicant. Clearly, selling goods by consignment, as alleged by the Examiner, simply fails to even suggest “trigger[ing] said supplier of said computer program product to charge said seller for a licence to use said computer program product” (emphasis added), in the context claimed by applicant.

Additionally, applicant respectfully asserts that since independent Claim 1 is non-obvious, then all claims depending therefrom are non-obvious. Note excerpt from MPEP below.

“‘All words in a claim must be considered in judging the patentability of that claim against the prior art.’ In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).” See MPEP 2143.03

Therefore, applicant has again adequately traversed the Examiner's assertion of Official Notice, and again thus formally requests a specific showing of the subject matter in ALL of the claims in any future action. Note excerpt from MPEP above.

Additionally, applicant asserts that Ishibashi teaches that “[t]he content providers 602 to 604, who provide the encrypted content to the user, collect the content use fee when providing of the content use rights discrimination card to the users, thereby avoiding on-line fee collection from the users” (Col. 9, lines 35-39 – emphasis added). However, teaching that the content providers 602 to 604, who provide the encrypted content to the user, avoid on-line fee collection from the users, as in Ishibashi clearly *teaches away* from the Examiner's allegation “it would have been obvious...to have modified the teachings of Ishibashi to use consignment in order to reduce the risk on the part of the seller, which makes them more likely to carry the product,” as alleged by the Examiner, since the content providers 602 to 604 also collect the content use fee when providing of the content use rights discrimination card to the users. It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)

Thus, applicant respectfully asserts that the first element of the *prima facie* case of obviousness has not been met, as noted above.

Again, applicant respectfully asserts that at least the first and third elements of the *prima facie* case of obviousness have not been met, since it would be *unobvious* to combine the references, as noted above, and the prior art excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above. Thus, a notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

Therefore, all of the independent claims are deemed allowable. Moreover, the remaining dependent claims are further deemed allowable, in view of their dependence on such independent claims.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 505-5100. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1351 (Order No. NAI1P490).

Respectfully submitted,
Zilka-Kotab, PC

/KEVINZILKA/

P.O. Box 721120
San Jose, CA 95172-1120
408-505-5100

Kevin J. Zilka
Registration No. 41,429